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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/090,067      | 06/03/1998  | JAMES D. REDMOND     | NIS0007             | 3497             |

23735 7590 04/05/2004

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 250  
TUALATIN, OR 97062

EXAMINER

HENDERSON, MARK T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3722

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/090,067

Applicant(s)

REDMOND ET AL.

Examiner

Mark T Henderson

Art Unit

3722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,3-6,8-11,13-16,18-21 and 23-26.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: \_\_\_\_\_

  
A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

Continuation of 2. NOTE: In regards to applicant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on the combinations of references. The UK Patent ('461) is cited for disclosing a document having a first printed matter at a first location and a first scale and color, and a second printed matter representing the first printed matter at a second scale, location and color, wherein the second printed matter is not ascertainable by the naked eye under normal use. The Dow reference is cited for disclosing a document comprising a first printed matter in a first color and a second printed matter in a second color, wherein there is minimal contrasting hiding between the first printed matter and the second printed matter. The Dow reference further discloses wherein the first printed matter and second printed are being compared. Therefore, it would have been obvious to one having ordinary skill in the art to modify the UK Patent's document to include minimal contrasting between the first and second colors as taught by Dow for the purpose of preventing the document from being counterfeited as well as providing a further means in which to secure an original document from being tampered. The Richardson reference is cited for disclosing a document having printed matter markers placed at different locations and at different scales, wherein the printed matter is unresolved unless the viewing person knows the second confidential location. Therefore, it would have been obvious to modify the UK Patent's document with printed matter placed at a confidential location which can only be resolved with the viewing person knowing where the printed matter location as taught by Richardson for the purpose of providing a covert means in which to secure the document from tampering or counterfeiting.

In response to applicant's argument that the prior art does not disclose "wherein a comparison of the second printed matter to first printed matter is capable of determining the authenticity of the identification document", the examiner submits that this limitation was not disclosed in the previous amended claims and will require further search and consideration. However, applicant must note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, a comparison of the printed matter (first and second) in the UK Patent's document as modified by Dow and Richardson is capable of determining the authenticity of the document.